

### **REMARKS**

Applicants have reviewed the Advisory Action mailed September 2, 2004 (Paper No. 8312004) and thank the Examiner for review of the pending claims. By this Amendment, Claims 1 and 10 are amended and Claim 20 has been added, however, no new matter has been added. Accordingly, Claims 1-4, 6-13 and 20 remain pending. Applicants request reconsideration of the pending claims in view of the above amendments and the following remarks.

#### **Interview Summary**

Applicants thank the Examiner for the courtesy of the telephone interview on September 27, 2004. During the course of the interview, the Examiner indicated that amending independent claims 1 and 10 to include the limitation of “by weight, at least about twenty eight percent but not greater than about thirty percent” would remove the objection that the proposed amendments in the Final Office Action raise the issue of new matter. Additionally, per the Examiner’s request, Applicants have amended the specification to reflect this limitation. Accordingly, Applicants have amended claims 1 and 10 to include this limitation.

#### **Detailed Action**

The Final Office Action objects to the amendment filed on March 5, 2004 under 35 U.S.C. §132 because it introduces new matter into the disclosure. Specifically, the Office Action asserts that the added material “said chlorinated polyethylene polymer having a percentage, by weight, less than thirty percent of the material composition of said inner tubular portion” is not supported by the original disclosure. Applicants respectfully traverse the objection.

As stated above, Applicants have amended independent claims 1 and 10 to include the limitation of “by weight, at least about twenty eight percent but not greater than about thirty percent”. The specification includes a table on page 5 that details the components, their description and a range for parts by weight of the components. The hose of Applicants’ claimed invention may be manufactured with a range of parts by weight, the maximum being

330 parts by weight and the minimum being 233 parts by weight. For example, the hose may be made with 90 parts by weight of chlorinated polyethylene polymer, and have a total of 320 parts by weight. As a result, the percentage, by weight, of chlorinated polyethylene polymer is approximately 28%. Thus, the hose of Applicants' claimed invention may include the feature that the chlorinated polyethylene polymer has a percentage, by weight, at least about twenty eight percent but not greater than about thirty percent of the material composition of the inner tubular portion without the addition of new matter. Accordingly, Applicants' respectfully request withdrawal of the rejection.

New independent claim 20 has been added including the features, *inter alia*, of an inner tube portion made of a chlorinated polyethylene polymer having a parts by weight of approximately 90-100, a plasticizer having a parts by weight of approximately 35-55, a reinforcing agent having a parts by weight of approximately 100-150, a heat stabilizer having a parts by weight of approximately 5-20, antidegradants having a parts by weight of approximately 0.5-3, process aids having a parts by weight of approximately 0.5-2, and vulcanizing agents having a parts by weight of approximately 8-25. Claim 20 is based upon the table on page 5 of the specification.

Claim Rejections under 35 U.S.C. § 112, first paragraph

Claims 1-4 and 6-9 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, claims 1-4 and 6-9 were rejected because claim 1 as described above constitutes new matter. Applicants respectfully traverse the rejection. For at least the reasons stated above, claim 1 has been amended to overcome the objection that claim 1 includes new matter. Therefore, claims 1-4 and 6-9 contain subject matter which is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, has possession of the claimed invention. Accordingly, Applicants respectfully request withdrawal of the rejection.

Claim Rejections under 35 U.S.C. § 103(a)

1. Claims 1-4, 6, 7 and 10-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,366,746 to Rosencrans in view of U.S. Patent No. 4,190,088 to Lalikos et al. Applicants respectfully request withdrawal of the rejection.

Applicants agree with the Examiner that Rosencrans does not teach that the amount of CPE used can be less than 30% by weight. However, Applicants disagree with the Examiner that the percentage, by weight, of CPE is merely a choice of mechanical expedients.

The percentage, by weight, of CPE taught in the Rosencrans reference is necessary for the success of the invention. Specifically, the Rosencrans reference discloses that “**in order to achieve the desired physical characteristics**, the chlorine content of the cross-linked chlorinated polyethylene, and the **percentage of the cross-linked chlorinated polyethylene** with respect to the complete hose composition is **significant**”. *See col. 4, lines 55-59*. Moreover, “**in order to produce the desired strength characteristics** required to resist the internal pressures within the hose, and to also maintain the cost of manufacture at a minimum with respect to the characteristics desired, **the percentage, by weight**, of the cross-linked chlorinated material is **between 30% and 70%**”. *See col. 5, lines 9-15*. Accordingly, the percentage, by weight, of CPE is not merely a choice of mechanical expedients, but is necessary for the success of the invention.

The proposed modification cannot render the prior art unsatisfactory for its intended purpose. *See MPEP 2143.01*. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. As stated above, the percentage, by weight, of CPE taught in the Rosencrans reference is necessary - and significant - for the success of the invention. Modifying the percentage of the CPE to be outside the range specified would render the Rosencrans invention unsatisfactory for its intended purpose. Thus, there is no suggestion or motivation to make the proposed modification.

Accordingly, the Rosencrans reference, taken singly or in combination with the Lalikos reference fails to provide a suggestion or motivation to make the proposed modification as required under 35 U.S.C. § 103(a).

Moreover, the Rosencrans reference, taken singly or in combination with the Lalikos reference fails to teach all the claim limitations of Applicants' claimed invention as required under 35 U.S.C. § 103(a). Specifically, Rosencrans fails to disclose the feature of the chlorinated polyethylene polymer having a percentage, by weight, of at least about twenty eight percent but not greater than about thirty percent of the material composition of the inner tubular portion. Accordingly, Applicants respectfully request withdrawal of the rejection.

Furthermore, Applicants' claimed invention includes the feature of a dye containing urethane deposited over and into the layer of yarn. The dye, which contains urethane, provides the hose with improved abrasion resistance and improved surface characteristics. The dye is able to seep into the strands of the textile yarn layer and seal the textile yarn so that fiber strands do not hang from the hose and catch on rough surfaces that the hose may be dragged over. In contrast, Lalikos teaches a chafe or fire sleeve 13, 14 for a hose having an outer layer that contains urethane. While the Lalikos sleeve 13, 14 includes urethane, and may even include a pigment to provide the sleeve with color, the sleeve 13, 14 itself is not a dye as claimed by the Applicants.

Applicants' respectfully submit that since Claims 2-4, 6 and 7 depend directly or indirectly from independent Claim 1, and Claims 11-13 depend directly or indirectly from Claim 10, the rejections pertaining to Claims 2-4, 6, 7 and 11-13 are overcome in view of the above comments. Claims 2-4, 6, 7 and 11-13 therefore are allowable for at least the same reasons as Claims 1 and 10.

2. Claims 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosencrans in view of Lalikos as applied to Claims 1-4, 6 and 7, and in further view of U.S. Patent No. 5,683,773 to Kemper. Applicants' respectfully request withdrawal of the rejection.

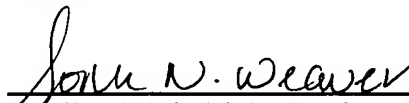
As stated above, the Rosencrans reference, taken singly or in combination with Lalikos and Kemper, fails to provide a suggestion or motivation to make the proposed modification and fails to disclose all of the claim limitations of Applicants' claimed invention as required under 35 U.S.C. § 103(a) as applied to Claim 1. Applicants respectfully submit that since claims 8 and 9 depend directly or indirectly from Claim 1, the rejections pertaining to claims 8 and 9 are also overcome in view of the above comments. Claims 8 and 9 are therefore allowable for at least the same reasons as Claim 1. Applicants respectfully request withdrawal of the rejection.

**CONCLUSION**

Should the Examiner believe anything further would be desirable in order to place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney at the telephone number listed below.

It is believed that any additional fees due with respect to this paper have already been identified. However, if any additional fees are required in connection with the filing of this paper, permission is given to charge Deposit Account Number 50-3145 in the name of Honigman Miller Schwartz and Cohn LLC.

Respectfully submitted,



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